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C2  
Contd

--21. The method according to claim 19, wherein the O/W emulsion comprises tocopheryl acetate.--

--22. The method according to claim 19, wherein the ratio of glycerol stearate citrate to cetylstearyl alcohol is about 1:1.--

#### CONDITIONAL PETITION FOR EXTENSION OF TIME

If entry and consideration of the amendments above requires an extension of time, Applicants respectfully request that this be considered a petition therefor. The Commissioner is authorized to charge any fee(s) due in this connection to Deposit Account No. 14-1263.

#### ADDITIONAL FEE

Please charge any insufficiency of fees, or credit any excess, to Deposit Account No. 14-1263.

#### REMARKS

Applicants respectfully request reconsideration and allowance of this application in view of the amendments above and the following comments.

The previous claims have been replaced by a new set of claims, which requires a content of at least one of glycerol and/or tocopheryl acetate in accordance with the specification at page 2, lines 9-17, and the examples. The new claims are not believed to introduce any new matter.

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Claims 11-14 were rejected under 35 USC § 112, first paragraph, as containing new matter. In response, while Applicants do not agree with the Examiner's position, Applicants point out that the corresponding new claims do not recite "an effective amount."

Claims 11-14 were rejected under 35 USC § 112, second paragraph, as being indefinite. In response, Applicants again point out that the corresponding new claims do not recite "an effective amount."

Claims 9-14 were rejected under 35 USC § 103(a) as being obvious over either FR 1,437,366 ("FR '366") or DE 3,820,693 ("DE '693") each alone or taken in view of US 5,770,185 ("US '185"). In response, Applicants respectfully request that the Examiner reconsider and withdraw this rejection.

The Examiner concedes that neither FR '366 nor DE '693 teaches cetylstearyl alcohol, which is a requirement of the instant claims. Consequently, Applicants do not believe that even the Examiner would disagree that this rejection is not properly based on FR '366 or DE '693 "*alone*." Therefore, if this rejection is maintained, then Applicants respectfully request that the Examiner remove the aspect of the rejection based on FR '366 or DE '693 alone or, if it is not removed, explain the basis of the rejection based on FR '366 or DE '693 alone.

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With respect to the combination rejection of FR '366 or DE '693 in view of US '185, Applicants again respectfully point out that the instant method claims expressly require the content of glycerol stearate citrate and cetylstearyl alcohol is incorporated into the O/W emulsion to reduce the stickiness thereof. The Examiner concedes that neither FR '366 nor DE '693 teaches cetylstearyl alcohol. US '185 teaches cetylstearyl alcohol, but concededly only as a co-emulsifier. Consequently, the combination of references does not teach or suggest that the incorporation of a combination of glycerol stearate citrate and cetylstearyl alcohol is effective to reduce the stickiness of an O/W emulsion. Accordingly, persons skilled in the art would not, in fact, have found it obvious from the cited combination of reference to incorporate a combination of glycerol stearate citrate and cetylstearyl alcohol into an O/W emulsion for the purpose of reducing the stickiness of the O/W emulsion.

The Examiner takes the position that "[a]ny properties provided to the emulsions by the incorporation of these components is inherent and not given patentable weight." In response, Applicants submit that this is clear error, as *it is improper to ignore any property in an obviousness analysis*. As held by the Court of Customs and Patent Appeals in the landmark decision in *In re Papesch*, 137 USPQ 43 (CCPA 1963):

"From the standpoint of patent law, a compound and all of its properties are inseparable; they are one and the same thing. The graphic formulae, the chemical nomenclature, the systems of classification and study such as the concepts of homology,

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isomerism, etc., are mere symbols by which compounds can be identified, classified and compared. But a formula is not a compound and while it may serve in a claim to *identify* what is being patented, as the metes and bounds of a deed identify a plot of land, the *thing* that is patented is not the formula but the compound identified by it. And the patentability of the thing does not depend on the similarity of its formula to that of another compound but of the similarity of the former compound to the latter. ***There is no basis in law for ignoring any property in making such a comparison.*** An assumed similarity based on a comparison of formulae must give way to evidence that the assumption is erroneous. [Plain italics in original and bold italics added.]”

The Examiner cites *Ex parte Obiaya*, 227 USPQ 58, 60 (BPAI 1985), in support, but Applicants submit that this case does not, in fact, support the Examiner’s position. Where the prior art teaches (as opposed to suggesting) a particular thing, it is appropriate to inquire as to the inherent characteristics of that thing. Thus, in *Obiaya*, the prior art taught a labyrinth heater, and, thus, applicants’ alleged benefits of using a labyrinth heater, i.e., a shorter response time, were inherent. Here, however, the Examiner is alleging inherency in something that does not, in fact, exist in the prior art, i.e., the claimed O/W emulsion, but, rather, in something that would result (i.e., is suggested) if the prior art were modified as the Examiner proposes. There is no support whatsoever in the patent law for inquiring into the inherent properties of a proposed modification of prior art.

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With respect to the issue of inherency, it might be helpful for the Examiner to consider the decision in *In re Shetty*, 195 USPQ 753, 756-757 (CCPA 1977). The claims therein were drawn to a method of curbing appetite in animals by administering to the animals certain adamantane compounds. Certain similar compounds had previously been administered to animals, *but for other purposes*, i.e., to combat viral infections, to reduce blood sugar content and to treat depression. The Examiner therein reasoned that the claimed method was obvious because the compounds had previously been administered to animals in the same amount and, thus, the prior art technically taught the method step claimed.

The Court, in response, held that the *purpose* that is to be achieved is a factor to be considered in the obviousness of a claimed method of use. Thus, on pages 756-757, the Court comments:

"The issue here is whether the claimed method of curbing appetite would have been obvious. That appellant's 'amount effective to curb appetite' corresponds to or inheres in Narayanan's amount 'to combat microbial infestation' does not persuade us of the obviousness of appellant's method. As this court said in *In re Naylor* [citations omitted]:

*[Inherency] is quite immaterial if, as the record establishes here, one of ordinary skill in the art would not appreciate or recognize that inherent result. \*\*\**

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\*\*\* we find nothing in the record which would afford one of ordinary skill reason to anticipate that a trial \*\*\* [of the combined prior art teachings] would be successful in producing the polymer recited in the claims.

The Patent Office has failed to show a reasonable expectation, or some predictability, that Brake's compound *would be an effective appetite suppressant* if administered in the dosage disclosed by Narayanan. The mere hindsight assertion that corresponding dosages render appellant's method obvious is untenable. *Prior to appellant's disclosure, none of the adamantane compounds in any of the references suggested a use, much less a dosage, for curbing appetite.* What we said in *In re Spormann* [again, citations omitted], relative to inherency applies equally here:

*As we pointed out in In re Adams [citations omitted], the inherency of an advantage and its obviousness are entirely different questions. That which may be inherent is not necessary known. Obviousness cannot be predicated on what is unknown (emphasis added)."*

There is nothing in US '185 or in its combination with FR '366 and DE '693 that teaches or suggests that cetylstearyl alcohol has any stickiness reducing effect either alone or in combination with glycerol stearate citrate. Consequently, a person having ordinary skill in the art would not have expected that the stickiness of an O/W emulsion could be reduced by incorporating into the emulsion a combination of glycerol stearate citrate and cetylstearyl alcohol, as instantly claimed. Therefore, the instant method claims are not *prima facie* obvious over the cited combination of references.

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With respect to the instant formulation claims, the Examiner concludes that it would have been obvious to substitute cetylstearyl alcohol expecting to obtain a stable emulsion. However, it is surprisingly disclosed in the instant specification that the combination of glycerol stearate citrate and cetylstearyl alcohol has the effect of reducing the stickiness of an O/W emulsion. As this effect is not taught or suggested by the prior art, this result is surprising and unexpected, and, therefore, an objective indication of nonobviousness.

In view of the foregoing, Applicants submit that the Examiner would be fully justified to reconsider and withdraw this rejection. An early notice that this rejection has been reconsidered and withdrawn is, therefore, earnestly solicited.

**Form PTO 1449**

Box 17 on the Summary Page of the Office Action dated May 1, 2001, is checked, indicating that an acknowledged copy of Form PTO 1449 is being returned to Applicants. However, Applicants did not receive a copy of that form, and respectfully request that another copy of that form be sent along with the next Office Action or, hopefully, a Notice of Allowance.

Applicants believe that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

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Applicants also believe that this application is in condition for immediate allowance.

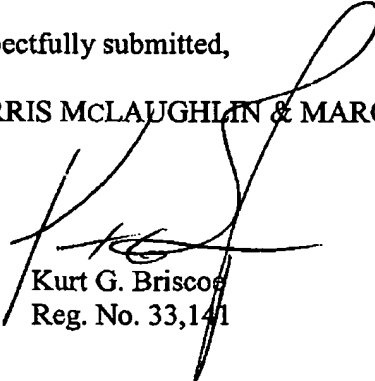
However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Early and favorable action is earnestly solicited.

Respectfully submitted,

NORRIS MCLAUGHLIN & MARCUS, P.A.

By

  
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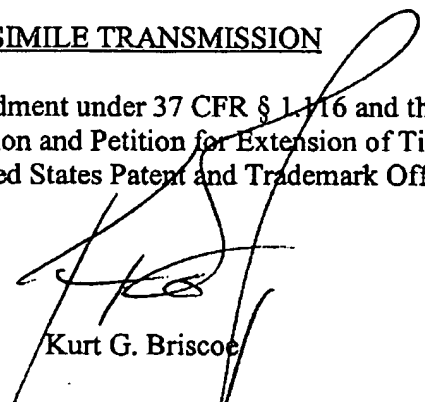
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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Amendment under 37 CFR § 1.116 and the accompanying Request for Continued Examination and Petition for Extension of Time (14 pages total) are being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below:

Date: February 26, 2003

By

  
Kurt G. Briscoe